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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,357	07/17/2001	Daniel Yam	YAM 1	1056

1444 7590 10/21/2003

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WASHINGTON, DC 20001-5303

EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

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DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/830,357

Applicant(s)

YAM, DANIEL

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on May 2, 2003 & August 8, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 61-67, 71-73, 75-92, 97-100 and 102 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) 84-86 and 91 is/are allowed.

- 6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.

- 7) ☒ Claim(s) 90 is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 30, 2003 has been entered.

#### ***Claim Objections***

2. Claims 79-83 and 87-88 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Note the base claims herein recite "consisting essentially off," the "further comprising" herein is beyond the scope of the base claims.

3. Claim 90 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Claim Rejections 35 U.S.C. 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 61-65, 71-73, 77-83, 87-92, 97-100, and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagiwara (JP07292385), in view of W. R. Grace (GB Patent 1,146,558), Nippon Grease (JP 56079194), and in further view of Moskowitz (U.S. Patent 5,268,186), Merck index and applicants admission at page 7, lines 20-26 and page 12, line 1-11.

3. Hagiwara teaches that fish oil and beeswax is known to be employ together in health food. In a particular example, the ratio of fish oil and beeswax is 6:1. See abstract and example 3 in column 7.

4. Hagiwara does not teach expressly the employment of beeswax as a fat supplement to provide solid fat components, or the particular method of making the composition, or a composition consisting essentially of fish oil and beeswax.

5. However, W. R. Grace teaches that beeswax is useful for making a fatblend, which is suitable for spreads or other food product. See, particularly, page 3, lines 7-20. Further, it is well known in the art that beeswax comprising long chain fatty acid ester is solid at room temperatur (See, Merck Index, 1031), Nippon Grease teaches that beeswax is known to be used for solidifying liquid oil, such as fish oil. See the abstract.

6. Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a food product, or other health product, wherein the beeswax and fish oil are the essential ingredients. A person of ordinary skill in the art would have been motivated to make a food product, or other health product, wherein the beeswax and fish oil are the essential ingredients because beeswax and fish oil are known to be useful in health food product, and beeswax is well-known to containing solid fat and are useful for solidifying liquid oil. Further, employment of fish oil containing a high concentration of

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polyunsaturated fatty acid, (e.g., 80% omiga-3 polyunsaturated fatty acid) is obvious since it is known that high concentration of omiga-3 polyunsaturated fatty acid in a fatblend is desirable, and the high concentration omiga-3 polyunsaturated fatty acid is available publicly at the time the claimed invention was made (See, page 7, lines 20-26 and page 12, line 1-11 in the specification). Further, making a homogenous mixture by heating, mixing and cooling is considered within the skill of artisan. The optimization of a result effective parameter, e.g., the morphology of the blend, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Finally, employment of a flavoring agent known to be useful in food, such as parmesan cheese flavor, in a composition used for food product is obvious (See Moskowitz, column 6, example V). Note, Cain does not particularly require other ingredients, therefore, would meet the limitation of "consisting essentially of."

7. Claims 61, 66-67, 75-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xu (5,817,322, IDS), in view of Ding.

8. Xu teaches a pharmaceutical carrier comprising an oil and beeswax. The oil may be vegetable oils. See, particularly, the abstract, and the examples in columns 4-6. The mixture was prepared by melting the beeswax and add the melted beeswax to heated oil. See, column 2, line 6 to column 3, line 67. The beeswax is well known for usefulness in pharmaceutical composition, particularly for making ointment with oil. See, particularly, column 1, line 41 to column 2, line 5.

9. Xu does not teach expressly to make ointment, or a homogenous mixture of the oil and beeswax, or the particular oil herein.

10. However, Ding teaches an ointment, wherein beeswax and a vegetable oil are the carriers. See the abstract.

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Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ a homogenous mixture of beeswax and an oil, such as those herein listed as a carrier in a pharmaceutical composition.

A person of ordinary skill in the art would have been motivated to employ a homogenous mixture of beeswax and an oil, such as those herein listed as a carrier in a pharmaceutical composition because beeswax and vegetable oil are known to be used in pharmaceutical composition in a homogenous mixture form. Further, soybean oil, and Olive oil is well-known pharmaceutical acceptable carrier, the employment of such oil is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2<sup>nd</sup> 1387 (at 1388).

***Allowable Subject Matter***

Subject matters in Claims 84-86, 90-91 are allowable. The claims are directed to a food product which is homogenous semi-solid paste consisting essentially of fish oil and beeswax with a particular percentage of fish oil, the method of making the same.

The remarks and amendments submitted May 20, 2003 and August 8, 2003 have been fully considered. The arguments are moot in view of the new ground rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

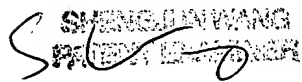
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Patent Examiner

A handwritten signature in black ink, appearing to read 'Shengjun Wang', is written over a rectangular stamp. The stamp contains the text 'SHENGJUN WANG' and 'PATENT EXAMINER' in a bold, sans-serif font.

Shengjun Wang

October 18, 2003